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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,527	06/28/2001	Stephanie Grasso	STEPH01	5137

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FRED GRASSO
2689 Mattox Creek Dr.
Oakton, VA 22124

EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 10/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/892,527	Applicant(s) GRASSO, STEPHANIE	
	Examiner Marie Patterson	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites a limitation which is already present in claim 8 from which it depends rendering the claim vague and indefinite as to what further structural limitations applicant intends to encompass with such language.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Smith (5661915).

Smith shows a system comprising a foot covering (10) with a flat tread bottom (14), a removable sole (16) comprising an elastic band (22), a planar surface (20), and a plurality of removable cleats (18) as claimed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 6, 8-10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (5661915) in view of Adair (3643352) and either Clerke (2911738) or Lorenzi (1684676).

Smith '915 shows a system substantially as claimed except for a substantially rigid planar sole plate. Adair teaches the well known and conventional practice of providing rigid sole plates (27) in a removable spiked footwear, specifically spiked overshoes/removable outsoles. Clerke or Lorenzi teaches making a rigid sole plate (3 or 4) which extends from the toe to the heel in a shape which substantially corresponds to the shape of the sole of the footwear. It would have been obvious to provide a rigid sole plate in the removable outsole as taught by Adair and to make the plate extend from the toe to the heel, i.e. in a shape which substantially corresponds to the sole of footwear as taught by either Clerke or Lorenzi in the system of Smith '915 to provide greater durability, stability, and to spread the forces transmitted by the cleats over the entire surface of the footwear.

6. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 5, 6, 8-10, and 12 above, and further in view of Smith (5836090).

Smith '915 as modified above shows a system substantially as claimed except for a toe cap and an anchor strap/support band over the top of the shoe. Adair teaches providing a toe cap (shown at 12 in figure 1) in a spiked removable outsole. Smith '090 teaches providing an anchor strap/support band (16 and 16') on a removable outsole. It would have been obvious to provide a toe cap as taught by Adair and to provide

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anchor strap/support band as taught by Smith '090 in the system of Smith '915 as modified above to provide a more secure attachment of the outersole to the footcovering.

7. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claims 5, 6, 8-10, and 12 above, and further in view of McNeil (4525939) and/or Carey (4299037).

Smith '915 as modified above shows a system substantially as claimed except for forming the cleats as turf knobs which are part of the outersole. McNeil and/or Carey teaches forming cleats as turf knobs which are formed as part of the outersole. It would have been obvious to form the cleats as turf knobs as taught by McNeil and/or Carey in the system of Smith '915 to reduce the cost and weight of the outersole.

In reference to claim 7, McNeil teaches forming cleats as truncated cones of differing heights (22, 16, and 38). It would have been obvious to provide cleats of differing heights as taught by McNeil in the system of Smith '915 as modified above to provide different traction properties to different areas.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith '915 in view of either Bauer (4377042), Folk (3009269), or Mastrocola (5615495).

Smith '915 as modified above shows a system substantially as claimed except for the bands being tapered. Bauer, Folk, or Mastrocola teaches forming bands with tapered walls (32, 22, or 38). It would have been obvious to taper the bands as taught by either Bauer, Folk, or Mastrocola in the system of Smith '915 to provide a smoother

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appearance of the connecting area between the foot covering and the removable outersole.

Smith '915 as modified above discloses the claimed invention except for the exact material for the band. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use spandex rubber for the band, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

9. Claims 13, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith '915 in view of McNeil (4525939) and/or Carey (4299037).

Smith '915 shows a method of using a system substantially as claimed except for forming the cleats as turf knobs which are part of the outersole. McNeil and/or Carey teaches forming cleats as turf knobs which are formed as part of the outersole. It would have been obvious to form the cleats as turf knobs as taught by McNeil and/or Carey in the method of Smith '915 to reduce the cost and weight of the outersole.

In reference to claim 7, McNeil teaches forming cleats as truncated cones of differing heights (22, 16, and 38). It would have been obvious to provide cleats of differing heights as taught by McNeil in the system of Smith '915 as modified above to provide different traction properties to different areas..

10. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 13, 18, and 19 above, and further in view of Smith (5836090).

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Smith '915 as modified above shows a method substantially as claimed except for an anchor strap/support band over the top of the shoe. Smith '090 teaches providing an anchor strap/support band (16 and 16') on a removable outersole. It would have been obvious to provide anchor strap/support band as taught by Smith '090 in the method of Smith '915 as modified above to provide a more secure attachment of the outersole to the footcovering.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 13, 18, and 19 above, and further in view of Adair.

Smith '915 as modified above shows a method substantially as claimed except for providing a toe cap on the removable outer sole. Adair teaches providing a toe cap on a removable outer sole. It would have been obvious to provide a toe cap as taught by Adair in the method of Smith '915 as modified above to provide a more secure attachment of the outersole to the foot covering.

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 13 above, and further in view of Adair and either Clerke (2911738) or Lorenzi (1684676).

Smith '915 as modified above shows a method substantially as claimed except for a substantially rigid planar sole plate. Adair teaches the well known and conventional practice of providing rigid sole plates (27) in a removable spiked footwear, specifically spiked overshoes/removable outsoles. Clerke or Lorenzi teaches making a rigid sole plate (3 or 4) which extends from the toe to the heel in a shape which substantially corresponds to the shape of the sole of the footwear. It would have been obvious to

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provide a rigid sole plate in the removable outsole as taught by Adair and to make the plate extend from the toe to the heel, i.e. in a shape which substantially corresponds to the sole of footwear as taught by either Clerke or Lorenzi in the method of Smith '915 to provide greater durability, stability, and to spread the forces transmitted by the cleats over the entire surface of the footwear.

Response to Arguments

13. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728